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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,595	01/30/2001	Peter Hossel	51186	8957
26474	7590	06/03/2005	EXAMINER	
NOVAK DRUCE DELUCA & QUIGG, LLP 1300 EYE STREET NW SUITE 400 EAST WASHINGTON, DC 20005			LAMM, MARINA	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/771,595

Applicant(s)

HOSSEL ET AL.

Examiner

Marina Lamm

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 9-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/17/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/17/05 has been entered.
2. Claims pending are 1-4 and 9-19.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The rejection of Claims 1-4 and 9-19 under 35 U.S.C. 103(a) as being unpatentable over Dieing et al. (EP 0 893 117) in view of Tanner et al. (US 5,827,508) and George et al. (US 6,165,449) is maintained for the reasons of the record.

### ***Response to Arguments***

5. Applicant's arguments filed 3/17/05 have been fully considered but they are not persuasive.

The Applicant argues: "...applicants' fail to agree with the Examiner that a reasonable person of ordinary skill in the art would be motivated to incorporate a metal oxide pigment into the hair conditioning composition which is addressed in the teaching of Dieing et al., especially since Dieing et al. seek to avoid build-up on the hair. As noted by the Examiner in her subsequent remarks 'one skilled in the art would have reasonably expected zinc oxide of Tanner et al. to remain on

Art Unit: 1616

the hair'. Accordingly, the Examiner acknowledged that an incorporation of the zinc oxide of Tanner et al. into the hair conditioning preparation of Dieing et al. would reasonably be expected to result in build-up. It is well settled that there is no suggestion or motivation to make a particular modification if the respective modification would render the prior art invention being modified unsatisfactory for its intended purpose). Since the teaching of Dieing et al. specifically seeks to avoid a build-up on the hair and in light of the Examiner's acknowledgement that build-up would result if metal oxide pigments were incorporated in the composition of Dieing et al., the modification of the teaching of Dieing et al. upon which the Examiner's arguments are based is clearly not suggested by the prior art and the motivation to do what applicants' have done is lacking." See p. 2 of the reply.

In response, it is noted that the "build-up effect" that the Dieing et al. reference seeks to avoid is due to the use of the cationic cellulose conditioners. "However, with these compounds a build-up effect is observed; in other words, on repeated use the hair becomes coated with the conditioner and has a heavy feel." See p. 1, lines 29-32. In addition, the compositions of Dieing et al. may contain other customary cosmetic additives, such as collagen, vitamins, protein hydrolysates, silicones, polymers, etc. At least some of these additional agents are likely to stay on the hair, but Dieing et al. do not seem to be concerned with a possible "build-up effect" from these agents. They are only concerned with a "build-up effect" from the cationic cellulose conditioners. Furthermore, Tanner et al. teach that their surface treated zinc oxide sunscreens avoid the shortcomings of the prior art zinc oxide sunscreens such as tendency to agglomerate and to cause whitening. Therefore, it can be reasonably concluded that the surface treated zinc oxide sunscreens of Tanner et al. will not cause an aesthetically unacceptable whitening effect ("build-up") when used in cosmetic compositions.

***Conclusion***

6. No claim is allowed at this time.

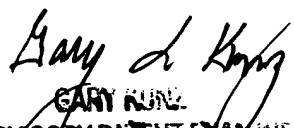
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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5/26/05

  
GARY KUNZ  
SUPERVISORY PATENT EXAMINER  
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